

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance or into better condition for appeal.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1, 2 and 4-8 are pending. Claim 1 is amended and claim 3 is cancelled, without prejudice.

No new matter is added by these amendments.

It is submitted that these claims are patentably distinct from the prior art cited by the Examiner, and that these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments and remarks herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112; but rather the amendments and remarks are made simply for clarification and to round out the scope of protection to which Applicants are entitled. Support for the amended recitations in claim 1 is found from cancelled claim 3 and from page 17 of the specification.

II. 35 U.S.C. §§102 AND 103 REJECTIONS

Claim 1 was rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Japanese Patent No. 09-153250 to Teichu. In addition, claims 2-4 and 6 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Teichu in view of U.S. Patent No. 5,470,435 to Yamamoto et al. Further, claim 5 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Teichu in view of U.S. Patent No. 5,809,206 to Seki. Finally, claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Teichu in view of Japanese Published Application No. 10134470 to Inoue. Applicants disagree.

The amendments to the claims render the rejections moot. For example, the amendment to claim 1 with the recitation of cancelled claim 3, claim 3 not rejected as allegedly being anticipated by Teichu, removes the Section 102 rejection.

Further, Applicants disagree with the Examiner's reasoning that the cited documents render the instant invention obvious. For example, none of the cited documents teaches, suggests or motivates a skilled artisan to practice an EOF regeneration function as recited in claim 1 (*see also* Specification at 17).

Moreover, the Examiner is respectfully reminded that "obvious to try" is not the standard upon which an obviousness rejection should be based. *See In re Fine*. And as "obvious to try" would be the only standard that would lend the Section 103 rejection any viability, the rejection must fail as a matter of law. Therefore, applying the law to the instant facts, the rejection is fatally defective and should be removed.

Consequently, reconsideration and withdrawal of the Section 102 and 103 rejections are respectfully requested.

CONCLUSION

By this Amendment, claims 1, 2 and 4-8 should be allowed; and this application is in condition for allowance or in better condition for appeal. Favorable reconsideration of the application, withdrawal of the rejections and prompt issuance of the Notice of Allowance are, therefore, all earnestly solicited.

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